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Attorney Docket No. 83010/F-P/EIS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Dale F. McIntyre et al.

**SYSTEM AND METHOD FOR
MANAGING IMAGES OVER A
COMMUNICATION NETWORK**

U.S. Serial No. 09/891,474

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Group Art Unit: 2154

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Commissioner for Patents

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APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134

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APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1-15, which was contained in the Office Action mailed July 24, 2006.

A timely Notice of Appeal was filed, December 18, 2006, which was received in the USPTO on December 20, 2006.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1-15 are pending in the application. These claims have been rejected and are being appealed.

Appendix I provides a clean, double spaced copy of the claims on appeal.

Status Of Amendments

The claims stand as indicated in Appendix I.

Summary of Claimed Subject Matter

The present invention, according to claims 1 and 11, is directed to a system and method, respectively, for managing digital images. *See* page 3, lines 25-26. In particular, the invention is directed to a device for creating an electronic icon, which contains information unique to a particular user. *See* page 20, lines 16-23; pages 9-10; Figs. 10a-10b. The icon allows access with respect to a digital media file over a communication network by a third party. *See* page 9, lines 7-24; Figs. 1 and 10a-10b. The icon then allows a third party who is associated with the icon to access the image on a computer in which the digital image and associated

icon are stored. *See* page 10, lines 17-18; page 9, lines 7-24; claims 1 and 11. The device for creating an electronic icon includes a user computer and the digital media file is stored in a memory device in the computer. *See* page 20, lines 16 - 23; Figs. 10a - 10b; claim 2. An example of its implementation is in a digital camera that captures an image and a unique icon is associated with the captured image. *See* page 30, line 13 - page 32, line 23; Fig. 21; claim 3. Further, the electric camera has a communication device for transferring the digital media file to a service provider in which the electronic icon includes instructions, which includes automatically forwarding of the digital image file to a third party, for further processing of the digital image file. *See* page 32, lines 7-18; page 9, line 7 - page 10, line 24; claims 5 and 8. The service provider provides confirmation of receipt of said digital media file to said electronic camera. *See* page 24, lines 11- 19; claims 6. The service provider also accesses the computer over the communication network to locate digital media files having said icon associated therewith and allowing access to said digital media files by said designated third party. *See* page 10, lines 2 - 10; page 9, lines 7 - 24; claims 11.

Grounds of Rejection to be Reviewed on Appeal

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 1, 2, 4, 9, and 11-14 are obvious under 35 U.S.C. 103(a) over Angiulo et al., U.S. Patent No. 6,275,829 (Angiulo) in view of Watanabe et al., U.S. Patent No. 6,578,072 (Watanabe).
2. Whether claims 3, 5, 6, and 8 are obvious under 35 U.S.C. 103(a) over Angiulo and Watanabe in view of Tomat et al., U.S. Patent No. 6,784,925 (Tomat).
3. Whether claim 7 is obvious under 35 U.S.C. 103(a) over Angiulo and Tomat in view of Motoyama, U.S. Patent Application Publication No. 2001/0054063 (Montoymana).

4. Whether claim 10 is obvious under 35 U.S.C. 103(a) over Angiulo (Angiulo, Wantanabe and Tomat) in view of Uchiyama U.S. Patent No. 6,731,341 (Uchiyama).

5. Whether claim 15 is obvious under 35 U.S.C. 103(a) over Angiulo and Watanabe in view of “Official Notice”.

Arguments

ISSUE No. 1. Angiulo in view of Watanabe et al., do not teach or suggest the inventions as set forth in claims 1, 2, 4, 9, and 11-14.

The present invention provides for an efficient way of sharing digital images among selected individuals and allowing selective access. This is accomplished by the creation of an icon that includes information allowing access to a particular digital media file that has the icon associated therewith with respect to an identified third party. The prior art fails to teach applicants inventions as set forth in the independent claims.

The Examiner in paragraph 4 of the Official Action states that the Angiulo teaches the “substantially” the invention and then proceeds to acknowledge in paragraph 5 that Angiulo does not explicitly teach that the icon contains information allowing access and information unique to a particular user. In order to render a claim obvious each and every claim limitation must be shown. The Examiner then relies on Watanabe as providing the missing limitation.

Angiulo fails to teach or suggest at least a device for creating an electronic icon containing information unique to a particular user including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party as required by Applicants’ independent claims 1 and 11, upon which the remaining claims depend at least ultimately. As admitted by the Office Action, Angiulo “does not teach that the icon contains information allowing access and information unique to a particular user.” Rather, Angiulo discloses creating a

thumbnail sized image that represents a reduced size of an original (larger) image. The thumbnail sized image can be inserted into a Web page providing a hyperlink associated to the original image. At best, the thumbnail image of Angiulo contains information to a particular (i.e., original) image, not information unique to a particular user as claimed by applicants. *See* Col. 7, lines 28-39. This user is not the same as a third party as claimed by applicant. In the present invention the third party is separate and distinct from the user of the icon that associates the icon with the image.

Wantanabe fails to remedy the deficiencies of Angiulo as Wantanabe also fails to teach or suggest at least a device for creating an electronic icon containing information unique to a particular user including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party. Rather, Wantanabe discloses that thumbnail images 25 are “low resolution images . . . having a lower resolution than that of the original image data.” *See* Col. 6, lines 4-8. A plurality of thumbnail images 25 can be registered into groups (Register Group A, B) by a system and network albums 26a-c can be formed therefrom. *See* Col. 7, lines 1 - 67; Fig 3. At best, Wantanabe discloses that a serial number can be associated with each thumbnail image 25 and an image ID 29 maps the thumbnail image 25 to the network album. *See* Col. 7, lines 60 - 67; Figs. 4. The album can be associated with more than one user. This is in contrast to the present invention where the electronic icon is associated with a particular user.

Furthermore, to access an album, the user must input a user ID and user password at a browser. *See* Col 8, lines 37 - 47; Fig 6. In sharp contrast, in Applicants’ invention, the electronic icon contains information unique to a particular user including information allowing access with respect to a particular digital media file by a third party. Thus, the thumbnail image 25 of Wantanabe is not an electronic icon containing information unique to a particular user including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party as required by Applicants’ independent claims.

In the Advisory Action dated December 11, 2006, the Examiner states “Angiulo does not specifically teach that the thumbnail image contains information unique to a user.” In this regard, as Applicants’ have previously pointed out, the claims specifically set forth that the icon includes information to allow access with respect to a particular digital media file having said icon associated therewith over communication network by a third party. It is the information allowing access by the third party, not by the user. This is important distinction as the user already has the image. With the present inventions directed to accomplishing is allowing automatic access by a third party different from the user. With regard to the ID set forth in Col. 8, lines 15-19, this ID refers to the ID of the album not to information for allowing a third party to have access to the image. The reference to Col. 9, lines 10-15, merely refers to association of the images by the user. See Col. 9, lines 18-19. Whereas, in the present invention, we are talking about access by a third party. Thus, the Angiulo reference does not disclose anything that would render Applicant’s independent claim obvious. Both Watanabe and Angiulo fail to teach an icon that includes information allowing access to a particular media file over a communication network by a third party as taught and claimed by Applicants.

ISSUE Nos. 2-5. Tomat, Motoyama, Uchiyama, and
OFFICIAL NOTICE do not add anything to Angiulo and Wantanabe that
would render dependent claims 3, 5, 6, 7, 8, 10 and 15 obvious under 35 USC
103(a).

It is respectfully submitted that further consideration of claims 3, 5, 6, 7, 8, 10 and 15 rejected under 35 USC 103(a) upon the citing of Tomat and Motoyama, is moot, inasmuch as the combination of Angiulo, Wantanabe, Tomat, Motoyama, Uchiyama and Official Notice still lack any teaching, disclosure, or suggestion concerning a device for creating an electronic icon allowing access with respect to a particular digital media file over a communication network by a third party as previously discussed.

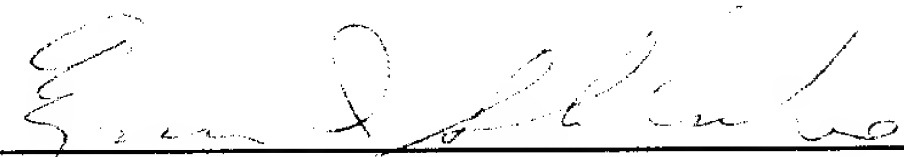
Summary

In summary, Applicant respectfully submits that the present invention is patentably distinct over the cited prior art.

Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims .1-15.

Respectfully submitted,



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Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

Appendix I - Claims on Appeal

1. A system for managing digital images, comprising:
a device for creating an electronic icon containing information unique to a particular user including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party.
2. The system according to claim 1 wherein said device for creating said electronic icon comprises a user computer and said digital media file is stored in a memory device in said user computer.
3. The system according to claim 1 wherein an electronic camera is used to create said electronic icon and automatically associates said electronic icon with digital media files captured by said electronic camera
4. The system according to claim 1 further comprising a communication device for transferring said digital media file from said user computer over said communication network.
5. The system according to claim 3 wherein said electric camera has a communication device for transferring said digital media file to a service provider wherein said electronic icon includes instructions for further processing of said digital image file.

6. The system according to claim 5 wherein said provider provides confirmation of receipt of said digital media file to said electronic camera.

7. The system according to claim 6 wherein said confirmation further includes confirmation of said instructions.

8. The system according to claim 5 wherein said instructions includes the automatically forwarding of said digital image file to a third party.

9. The system according to claim 2 wherein a service provider having access to said digital media file so as to obtain said icon and allow access in accordance with said information.

10. The system according to claim 5 wherein said communication device is a wireless phone.

11. A method for managing digital images by a service provider on a computer of a user over a communication network, comprising:
creating an electronic icon containing information unique to said user that includes information for allowing controlled access by a designated third party to a particular digital media file stored on said computer;
said service provider accessing said computer over said communication network and locating digital media files having said icon associated therewith and allowing access to said digital media files by said designated third party.

12. The method according to claim 11 wherein said information comprises instruction with respect to said digital image files

13. The method according to claim 12 wherein said instructions comprises forwarding said digital media file to said designated third party.

14. The method according to claim 13 wherein said instructions comprises forwarding an electronic address of said digital media file to said designated third party such that said designated third party may directly access said digital media file.

15. The method according to claim 14 wherein said digital media file is a low resolution copy of a higher resolution media file.

Appendix II - Evidence

NONE

Appendix III – Related Proceedings

NONE